

REMARKS

Applicant has studied the Office Action dated February 6, 2008. Claims 75, 92, 93 and 99 have been amended. It is submitted that the amendments to the claims have support in the application as originally filed and, therefore, no new matter has been added.

Claims 63-67, 69-71 and 75-99 are pending, with claims 63-67, 69-71, 80-89 and 98 having been previously withdrawn from consideration. Claims 63 and 75 are independent claims.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 102 Rejections

Claims 75-79, 90, 91, 93, 96 and 99 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hsu (U.S. Patent No. 5,907,604). Applicant respectfully disagrees with the Examiner's interpretation of Hsu and respectfully traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With regard to the rejection of independent claim 75, it is respectfully noted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that claim 75 recites that a virtual image created by the receiving party is pre-stored in a receiving party terminal and that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own perception of the calling party. It is respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that Hsu fails to disclose these limitations.

It is respectfully noted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that the disclosure in Hsu is specifically that “**the calling party** may define the image to be **associated with their Caller ID**” and that the “**calling party** transmits an image … prior to, or concurrently with, a telephone call intended to be answered by the receiving party” and that “image is stored in … the receiving party’s telephone system along with an indication of the **Caller ID of the calling party**” such that the “next time the calling party calls the receiving party, the previously stored image is accessed and displayed.” See Hsu at col. 2, ll. 14-23 (emphasis added).

It is respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that Hsu fails to disclose that the pre-stored image is based on at least one of the receiving party’s prior knowledge of a calling party and the receiving party’s own perception of the calling party. It is further respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that Hsu discloses instead that the image is “associated with [the calling party’s] Caller ID” and that the image is transmitted either “prior to” or “concurrently with” a telephone call to the “receiving party” and stored in the “receiving party’s” telephone system with an “indication of the Caller ID of the calling party” or, in other words, that the “receiving party’s” prior knowledge of a calling party and the “receiving party’s” own perception of the calling party is not a consideration in the “image” that is “associated with [the calling party’s] Caller ID.”

It is respectfully noted that the Examiner, in the Response to Arguments at paragraph 1 on pages 2-7 of the present Final Office Action, fails to address the Applicant’s arguments presented in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007 and reiterated herein with regard to the recitation in independent claim 75 that the pre-stored image is based on at least one of the receiving party’s prior knowledge of a calling party and the receiving party’s own perception of the calling party. Therefore, it is It is respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that Hsu fails to disclose this limitation.

It is further respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that Hsu does not disclose a virtual image created by the receiving party is stored in the receiving party terminal, as recited in independent claim 75, but rather discloses that an image defined by “the calling party” is transmitted to and stored in “the receiving party’s telephone system.” It is respectfully noted that the Examiner, in the Response to Arguments at paragraph 1 on at page 4 of the present Office Action, indicates that he partially agrees with the previously submitted arguments that Hsu does not disclose a virtual image created by the receiving party is stored in the receiving party terminal and further asserts that the disclosure in Hsu supports that “at the very beginning, image is defined by the calling party and stored and the receiving party can later make other refinements to alter the image as stored and any calls after that the refinement pre-stored image is displayed and this image is considered created at least partially by the receiving party.”

Applicant respectfully submits that even if the disclosure in Hsu arguably supports a virtual image “partially” created by the receiving party, that disclosure is not sufficient to anticipate the recitation in claim 75 of a virtual image created by the receiving party given the disclosure in the specification that must be taken into account when interpreting the claim, that disclosure supporting an interpretation of created by the receiving party as precluding that the image is “partially” created by the receiving party. Applicant further respectfully submits that even if the disclosure in Hsu were deemed sufficient to anticipate the recitation in claim 75 of a virtual image created by the receiving party, the Examiner still has failed to provide support that Hsu discloses that the virtual image is created based on at least one of the receiving party’s prior knowledge of a calling party and the receiving party’s own perception of the calling party.

However, in the interest of furthering the prosecution of the present claims, it is respectfully noted that independent claim 75 has been amended with this paper to recite a virtual image entirely created by the receiving party. It is respectfully submitted that support for the amendment may be found at at least paragraphs 13, 51, 52, 63 and 84 of the specification as originally filed. It is further respectfully submitted that even with

the Examiner's interpretation of Hsu as disclosing a virtual image created "at least partially by the receiving party," the disclosure is not sufficient to disclose a virtual image entirely created by the receiving party, as presently recited in independent claim 75.

With regard to the rejection of claim 93, it is respectfully noted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that the disclosure in Hsu is that "[v]ideophone 280 also receives composite video information from, e.g., external video cameras at 282" and that "[v]ideophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288." See Hsu at col. 4, ll. 57-61. It is further respectfully noted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that the disclosure in Hsu is that "[s]till camera 290 transfers picture information to the desktop PC, notebook PC and PDA." See Hsu at col. 4, ll. 61-63.

It is respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that the proper interpretation of the cited portion of Hsu is that the "videophone 280," "external video cameras at 282" and "still camera 290" in FIG. 4 of Hsu are located at the "calling party" and the "information" is transferred to a "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" that are located at the "receiving party." In support of the Applicant's submitted interpretation of Hsu, the Examiner's attention is respectfully directed, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, to the disclosure at col. 2, ll. 14-23 of Hsu that it is the "calling party" that defines the "image" that is "associated with their Caller ID" and it is the "calling party" that transmits the "image" to the "receiving party" as well as to col. 5, ll. 13-55 of Hsu, which discloses that "the operations of image capture 350 ... are performed at the transmitting end ... performed by components at the sending, or calling, party's end." Moreover, it is respectfully submitted, as it was in the response submitted on November 26, 2007 to the previous Office Action dated July 27, 2007, that there is no disclosure in Hsu of any selection by the receiving party of any format for transmitting the media information, as recited in claim 93.

It is respectfully noted that the Examiner, in the Response to Arguments at paragraph 1 on page 6 of the present Final Office Action, asserts that the disclosure at col. 4, ll. 54-64 of Hsu that “[v]ideophone 280 also receives composite video from, e.g., external video camera” is analogous to the recitation in claim 99 that the calling party selects the at least one format for transmitting the media information and the disclosure that “[v]ideophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” is analogous to the recitation in claim 93 that the receiving party selects the at least one format for transmitting the media information. Applicant respectfully disagrees with the Examiner’s asserted interpretation of the disclosure in Hsu.

It is respectfully submitted that the Examiner has not indicated any asserted analogies between the calling party and receiving party recited in claims 93 and 99 and the “videophone 280, “external video camera,” “desktop PC 284,” “notebook PC 286” and “personal digital assistant (PDA) 288” in the asserted portions of Hsu. It is further respectfully submitted that the Examiner has not indicated how the disclosure in Hsu that the “videophone 280 also receives compost video” is analogous to the “videophone 280” or “external video camera” selects any format nor how the “[v]ideophone 280 transfers information” is analogous to the “videophone 280” or “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” selects any format.

It is respectfully submitted that in view of the arguments presented herein, the only viable interpretation of Hsu is that “videophone 280,” “external video cameras at 282” and “still camera 290” in FIG. 4 of Hsu are located at the “calling party” and the “information” is transferred to a “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” that are located at the “receiving party.” Therefore, it is further respectfully submitted that the only transmitting of media information between a calling party and a receiving party that is arguably disclosed in Hsu is of a “videophone 280” of a calling party transmitting media information to a “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” of a receiving party.

It is respectfully submitted that the only portion of Hsu that arguably discloses which of the parties selects the format for transmitting information is at col. 2, ll. 14-23 and col. 5, ll. 13-55 and the disclosure at those portions of Hsu is explicitly that it is the

“calling party” or the “transmitting end” that performs all the operations. It is further respectfully asserted that there is no disclosure in Hsu that the “receiving party” has any effect on the selected format.

It is respectfully noted that the Examiner, in the Response to Arguments at paragraph 1 on page 7 of the present Final Office Action with regard to the 35 U.S.C. rejection of claim 92, asserts his opinion that “any selected format for transmitting determined by the calling party needs to be comparable with the capability of the receiving party, otherwise, media information transmitted from the calling party would not be able to reach the receiving party” and, therefore, determined at the receiving party terminal in claim 92 is broadly interpreted. While the Examiner’s opinion may be valid, it is respectfully submitted that his opinion and interpretation of the disclosure in Hsu is contradictory to the explicit disclosure in the specification to which the claims are directed.

It is respectfully noted that the present invention is directed to allowing the “communicating parties” to “control the amount of information they want to transmit based on how much they are willing to pay for various communication services” and to allow “users to control the types of media services that they would like to receive, thereby allowing the users to control costs and the extent of media services to be received.” See specification at paragraphs 19 and 68.

It is further respectfully noted that the present invention is directed to one embodiment where the receiving party may “designate one or more service options he or she would like to receive” in order to “control the type of media information to be received” and that the “user of the receiving terminal may enter into an agreement with the wireless carrier to ensure that only lower-bandwidth media is displayed” via a “controller at the switching station which blocks or otherwise filters out higher-bandwidth media” or “the receiving terminal may be configured to block display of higher-bandwidth media, even though it may have been sent by the transmitting terminal” or “the receiving terminal may be programmed to replace received media information with alternative media information stored in a terminal memory.” See specification at paragraphs 37-47. It is respectfully submitted that claim 93 is directed to this embodiment.

It is respectfully noted that the present invention is specifically directed to another embodiment where “the present invention controls the manner in which media information is displayed based on the person who sent the information.” See specification at paragraph 49. It is respectfully submitted that claim 99 is directed to this embodiment.

Therefore, it is respectfully submitted that unlike the conventional system that conforms to the Examiner’s asserted opinion, the present invention is specifically directed to **unilateral control** of the format for transmitting the media information and, therefore, allows for the information that the calling party transmits not being received by the receiving party. The Examiner’s attention is respectfully directed to the present specification at paragraphs 73-74, which specifically discloses that “the transmitting terminal may transmit continuous video output from the camera unit in the terminal” but the “receiving terminal may capture and then display the video, and in the meantime may store the script” so that “the receiving terminal may display this script repeatedly ... without requiring any additional allocation of network resources.”

Notwithstanding that Hsu fails to provide adequate disclosure to anticipate the **unilateral control** that is recited in claims 93 and 99, those claims have been amended with this paper to better disclose the invention by reciting that that the receiving party (claim 93) or the calling party (claim 99) unilaterally selects the at least one format for transmitting the media information. It is respectfully submitted that even with the Examiner’s interpretation of Hsu, the disclosure is not sufficient to anticipate unilaterally selects, as recited in claims 93 and 99.

It is respectfully asserted that independent claim 75 is allowable over the cited reference. It is further respectfully asserted that claims 93 and 99 also are allowable over the cited reference by virtue of the limitations recited therein as well as by virtue of its dependence from claim 75. Moreover, it is respectfully submitted that claims 74-79, 90, 91 and 96 also are allowable over the cited reference by virtue of their dependence from claim 75.

§ 103 Rejections

Claims 92 and 97 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu. This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

As previously submitted with respect to the arguments related to claims 93 and 99, the Examiner has incorrectly interpreted that recitation of determined at the receiving party terminal in claim 92 broadly. It is further respectfully submitted that the recitation of determined at the receiving party terminal implies a **unilateral control** of the determination of the at least one format for transmitting the media information that is not disclosed in Hsu.

Notwithstanding that Hsu fails to provide adequate disclosure to anticipate the **unilateral control** that is recited in claim 92, the claim has been amended with this paper to better disclose the invention by reciting that the at least one format for transmitting the media information is unilaterally determined at the receiving party. It is respectfully submitted that even with the Examiner's interpretation of Hsu, the disclosure is not sufficient to anticipate unilaterally determines, as recited in claim 92.

As previously asserted, independent claim 75 is allowable over Hsu. Therefore, it is respectfully asserted that claim 92 is allowable over the cited reference by virtue of the limitations recited therein as well as by virtue of its dependence from claim 75 and claim 97 is allowable over the cited reference by virtue of its dependence from claim 75.

Claims 94 and 95 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu, in view of Lev et al. (“Lev” U.S. Pat. No. 5,987,327). This rejection is respectfully traversed.

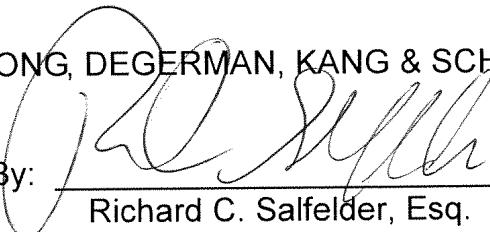
It is respectfully submitted that Lev fails to cure the deficiencies of Hsu with regard to a virtual image entirely created by the receiving party is pre-stored in a receiving party terminal and that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own perception of the calling party, as recited in independent claim 75. Therefore, it is respectfully asserted that independent claim 75 is allowable over the cited combination of references, as are claims 94 and 95, by virtue of their dependence from claim 75.

CONCLUSION

In view of the above remarks, Applicant submits that claims 75-79, 90-97 and 99 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

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